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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,325	08/31/2001	Everett C. Pesci	UIZ-068CP	1369

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EXAMINER	
HUANG, EVELYN MEI	
ART UNIT	**PAPER NUMBER**
1625	

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/945,325	PESCI ET AL.	
	Examiner	Art Unit	
	Evelyn Huang	1625	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): see attachment to advisory action.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *see attachment to advisory action.*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *1,3-13,15-42 and 46-48*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☒ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

Evelyn Huang
Primary Examiner
Art Unit: 1625

Attachment to Advisory Action

1. The objection to claims 20-34 under 37 CFR 1.75 as being a substantial duplicate of claims 1 and 19 is maintained for reasons of record, since the use recited in claims 20-28 does not further limit the compound of claim 1 or 19. Applicant argues that not all compounds of formula I are autoinducer molecules, the scope of claims 20-34 therefore is not the same as claims 1 or 19. However, such a concept has not been described in the specification, rather the contrary has been described (page 8 of the specification).

2. The scope rejection under 35 U.S.C. 112, first paragraph is maintained for reasons of record.

Applicant repeatedly contends that Bycroft makes absolutely no reference to quinolone compounds or quinolone compounds as autoinducers. Indeed, Bycroft's homoserine lactone compounds are cited to illustrate the unpredictability of the art because at the time of the invention, quionlone compounds as autoinducers have not been described.

Applicant argues that the two compounds described on page 24 of the specification is not within the scope of the claims and the compounds in the compound claims are not necessarily autoinducers. However, such a concept has not been described in the specification, rather the contrary has been disclosed (page 8 of the specification).

Applicant maintains that the examiner has arrived at the conclusion based on only one of the evaluation factors, while ignoring one or more of the others. On the contrary, it is in view of the state of the art, the high degree of unpredictability of the art, the absence of specific working examples, together with the fact that the scope of the claims does not commensurate with that of the objective enablement, that lead to the conclusion that sufficient teaching and guidance have not been provided in the specification to enable one of ordinary skill in the art to practice all the invention as claimed without undue experimentation.

3. The rejection for Claims 1, 4, 10-14, 19-28, 32-42, 46-48 under 35 U.S.C. 102(b) as being anticipated by Takeda (Hakko Kogaku Zasshi (1959), 37, 59-63, abstract) is maintained for reasons of record.

Applicant repeatedly alleges that Takeda's compound is not 2-heptyl-3-hydroxy-4-quinolone because it has a different melting point and different degree of antibacterial activity than the instant. The different physical data and/or different degree of biological activity presented in the specification do not invalidate the Takada reference, especially in view of the fact that it is well known in the art that a compound of a particular structural formula may exist in different physical forms having different melting points. Furthermore, the melting point of the instant 2-heptyl-3-hydroxy-4-quinolone (PQS) has not been recited in the claims. Takeda's compound having the same structural formula as the instant therefore meets every requirement of the claims, and therefore expressly anticipates the claimed invention. Since the reference relied on expressly anticipates or makes obvious all of the elements of the claimed invention, the reference is presumed to be operable. Once such a reference is found, the burden is on applicant to provide facts rebutting the presumption of operability. In re Sasse, 629 F.2d 675, 207 USPQ 107 (CCPA 1980). See also MPEP § 716.07. Applicant has provided arguments, but not convincing facts and evidence rebutting the presumption of operability.

4. The 112 second paragraph rejection for claims 14-16 is withdrawn in view of the cancellation of claim 14 and the amendment of claims 15-16.